

REMARKS

The Applicant appreciates the courteous and complete examination of the application by the Examiner. In view of the foregoing amendments and the following remarks, a reconsideration of the instant application is respectfully requested.

The Examiner rejected claims 13-17, 19, and 20-31 under 35 U.S.C. 103(a) as being unpatentable over the Schiller et al. reference. In order to expedite the prosecution of this application, claims 18, 22, and 28 have been canceled without prejudice or disclaimer of the subject matter thereof. Claims 13, 20, 23, and 27 have been amended to include additional limitations. Claims 13-17, 19-21, 23-27, and 29-31 are now in this application.

The Examiner states "It would have been obvious to one having ordinary skill in the art at the time the invention was made to change the shape of the back face, since there is no invention in merely changing the shape or form of an article without changing its function". The Applicant respectfully believes the Examiner is in error in the use of this assumption in the claim rejections. Independent claims 13, 20, and 27 were amended to include limitations from their respective cancelled claims which claimed "the outcoming ply of the frontal face is adapted to receive the lower plane curve of the top edge of the back face, thereby securing the back face in a closed position." It can be appreciated that the claimed shape does have specific function in that "the lower plane curve of the top edge of the back face" is received by "the outcoming ply of the front face", which secures the back face in a closed position. The Schiller reference does not disclose or suggest this claimed structure and corresponding function of the lower plane curve of the back face being received and secured by the frontal face. It is therefore believed that since the "Schiller et al. do not disclose the back of the box is formed of three curves", as stated by the Examiner in the above-identified office action, and since the present application claimed specific shape performs a specific function, that the amended independent claims 13, 20, and 27 be allowed.

Additionally, the Examiner states "Regarding claims 22, 23, and 28, Schiller et al. disclose the oblique ply in 221, 22b of the frontal face is adapted to receive the brow (unnumbered) thereby securing the back face in a closed position, and the frontal face is resistant against opposition of the cover (col 4, lines 4-10)." The Applicant would like

to point out that the brow is (unnumbered) in the Schiller reference because it is not disclosed or suggested therein. Furthermore, the top panel 14 in the Schiller reference "is secured to top panel 12 by a tab 15, which is preferably glued to top panel 12" (col. 2, lines 64-67). Amended claims 13, 20, and 27 do not have a glued tab to secure the back face to the front face. The specific structure and function of the back face is substantially different to that disclosed in the Schiller reference which teaches away from the present claimed invention.

The Examiner has stated that "the frontal face is resistant against opposition of the cover (col 4, lines 4-10)". The Applicant respectfully believes that the Examiner has misunderstood this section of the Schiller reference since it makes no reference or disclosure of resisting opening or opposition of the cover. This section of the Schiller reference describes how the rigidity of the sides of the Schiller litter box is enhanced by horizontal creases. The top panels 12 and 14, of the Schiller invention, are maintained in a closed position by tongue 13 being inserted "underneath top panel 14 as the top panels 12 and 14 close together" (col. 4, lines 50-57). The top panels 12 and 14 of the Schiller invention are also secured by the tab 15 being glued to the top panel 12. Amended claims 13, 20, and 27 are substantially different in structure and function to the Schiller reference in that the cover is secured in a closed position by the frontal face receiving the lower plane curve of the back face. The frontal face of the claimed present invention is "resistant against some opposition of the cover" by the two sharp corner curves of the top edge of the back which keep "the oblique plies of the side face into position". The Schiller reference does not disclose or suggest this claimed structure and corresponding function of the lower plane curve of the back face being received and secured by the frontal face while the two sharp corner curves keep the oblique plies of the side face into position. It can be appreciated that this specific structure performs a specific function that is not disclosed or suggested by the prior art references.

Moreover, the law is clear that a motivation must be provided by the prior art to make the allegedly obvious combinations of parts relied upon in making an obviousness rejection. Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art

references. See, e.g., *C.R. Bard, Inc. v. M3 Sys., Inc.*, 157 F.3d 140, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998).

And, absent such a showing of motivation in the prior art to make the allegedly obvious combination, it can only be assumed that the applicant's disclosure has provided the motivation for making the combination of elements from the prior art, and not the prior art itself.

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight. See e.g., *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985).

It is therefore submitted that the combination of individual parts taught by the various prior art references relied upon in the Office Action would not motivate one skilled in the art to arrive at the applicant's claimed invention.

The Applicant requests that the Examiner reconsiders his/her rejections of the invention in view of the well established principle that small differences in a crowded art can constitute patentable improvement. See *In re Baum*, 51 USPQ 470 (CCPA 1941) and *In re Lange*, 126 USPQ 365 (CCPA 1960). In considering this principle, the Applicant would also request that the Examiner take note to the court decision which notes that "apparent simplicity has been held to furnish strong argument for patentability where, as here, a need has existed for a structure of the nature disclosed and claimed. The fact that a solution to a problem is simple, or appears to be simple when viewed in retrospect, does not mean that the solution was obvious when it was conceived." See *Ellipse corp. v. Ford Motor Co.*, 171 USPQ 513.

Claims 14-17, and 19 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 13. Claims 21, and 23-26 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 20. Claims 29-31 are felt to patentably distinguish over the prior art references because of their above-mentioned dependency from amended claim 27.

With the above amendments being fully responsive to all outstanding rejections and formal requirements, it is respectfully submitted that the claims are now in condition

for allowance, and a notice to that effect is earnestly solicited. Should the Examiner feel that there are further issues which might be resolved by means of telephone interview, the Examiner is cordially invited to telephone the undersigned at (403) 444-5695, or email at davidguerra@verizon.net.

No additional fee is due.

Respectfully Submitted,



David A. Guerra, Reg. 46,443

CERTIFICATE OF TRANSMISSION/MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

On (Date) 12/22/2006 by David A. Guerra

